

**REMARKS**

The Examiner continues to reject claims 25 – 28, 33 – 40 under 35 USC 102 (e) as being anticipated by Wilkins (6038803) for reasons of record in the previous office action of May 25, 2005.

Claims 1, 4 – 8, 16 – 18 and 41 also continue to be rejected under 35 USC 103 (a) as being anticipated by Wilkins (6038803) for reasons of record in the previous office action of May 25, 2005.

The Examiner further continues to reject claims 14 – 15 and 31 – 32 under 35 USC 103 (a) as being anticipated by Wilkins (6038803) for reasons of record in the previous office action of May 25, 2005.

The Examiner rejects claims 1 and 9 due to Treglown (App GB 2 333 050) on the basis that Treglown includes PVC in the range of plastics which may be used in the application.

The Examiner rejects claims 1, 4 – 9, 14 – 18 and 25 – 35 as failing to comply with the written description requirement. He also rejects the amended specification as importing new matter.

**APPLICANT'S RESPONSE**

The applicant here amends those claims and specification aspects which refer to issues other than the previously cited Wilkins and Treglown arts and hopes that these are thus placed in a suitable condition. With regard to the mentioned arts, the applicant takes issue with the examiner's interpretation of the arts and hence their relevance to the application and seeks to persuade the Examiner here.

To restate : Following examination of the presently-cited art and the Examiner's comments, the Applicant is clear that no-one else has thought of, experimented with and developed (ie invented) a small, readily usable cling-technology, self-adhesive mount for mounting paper and other flat sheets to glass.

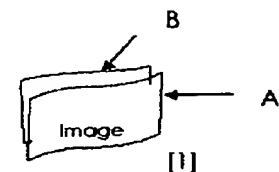
The fundamental inventive concept has been to consider the making of a tag, simultaneously optimised as to its material, size and other properties, which adheres itself to a larger sheet object and thus, by then adhering itself to the glass, adheres the said sheet object to glass. The present application describes a tool to apply to other sheet objects which will not themselves adhere to glass. Neither Wilkins (6038803) nor Treglown (App GB 2 333 050) teach such a mount, nor, it is contended, does the technology they employ inform the present application.

The applicant has previously submitted, as support material preparatory to the telephone interviews, illustrations showing his interpretation of the Wilkins and Treglown arts, plus illustrations of the present application, to show clearly the differences and the lack of anticipation of the present application by those.

This interpretation has not been rejected nor accepted in the discussions. Here, these illustrations are re-submitted formally, as part of the applicant's request that the examiner might look again at his interpretation and position on this.

### Illustration and Discussion of Wilkins and its Relevance to the Present Application

US 6038803 proposes a cling PVC sheet A, on the front surface of which is printed a decoration or image. This sheet, which is opaque, is then cut to a suitable size and adhered, by its back surface, to a glass-covered existing picture, by means of the sheet's cling properties.

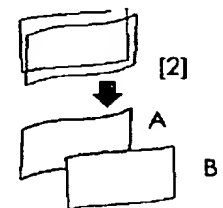


A protective backing sheet, B, is employed, as is the custom in the trade, to protect the back surface of the PVC sheet and thus maintain its cling properties.

At no time does Wilkins propose the creation of any assembly which involves adhesive. Indeed, the essence of the invention " ...is to provide a device for redecorating pictures to conform to a particular seasonal or other special event which can be readily secured over an existing picture without the use of adhesive."

Wilkins has patented a special use of the practice/materials employed in the production and use of self-cling PVC posters. It is a simple application for cling PVC. Generally, such posters will be printed in such a way as to be posted on the inside of a window and read from outside.

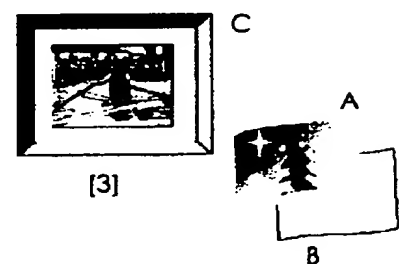
As in this example, fig [2], of a "Sale" sign, the protecting sheet, B, is Therefore placed on the face which will cling to the window.



Wilkins's image, however, is printed on the front of the sheet and the sheet is to be adhered by its back surface, and at no time does she show the protecting sheet on the front face of the cling sheet, as the Examiner infers.

### Here is Wilkins's device :

Wilkins envisages, claims, an original glass-covered Picture, C, which she proposes her invention to cover and change the subject matter temporarily. A is her temporary sheet, from the back of which the backing, protecting sheet is peeled before the sheet A is attached, by cling, to the glass of the original frame. Either the back of the invented

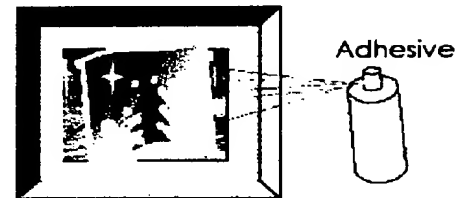


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sheet, or the back of the protecting sheet, B, may show a template, which enables the sheet to be cut to size. There is no adhesive – front or back of either sheet.

Fig [4] : Wilkins does realise that in fact the cling sheet may not attach by cling to the original picture – due, perhaps, to the use of micro-dimpled non-reflective glass – and adds, in a couple of places in her specification only, that one might, on an ad-hoc basis, adhere the intended cling sheet with a tacky adhesive instead.

The figure shows how this might be done, since nowhere does Wilkins present any version of her invention using a coating of adhesive.



[4]

In other words, as noted previously by the applicant, where Wilkins's invented sheet fails to work, she adds only as an aside that one might always use glue – and misinterpretation of this has been cited as being something which might inform the present application.

However, the most important aspect of Wilkins in this context is that at no time does she set out to invent a tool, a mount – for mounting a first sheet (which, like paper, is itself not capable of sticking to the glass) to a second material, a window or other glass. Wilkins does not teach a mount.

Wilkins's sheet only clings itself. Wilkins never mentions the use of her invented sheet as a mount for the purpose of attaching a first sheet to a second material.

Referring, as before, to the Examiner's Action of 23<sup>rd</sup> May, 2005, he says, inter alia :-  
 " Wilkins also teaches a method for securing a first material to a second material comprising releasably adhering a first surface of a mount to the first material (F) which is well known to be paper in the adhesive art, with an adhesive carried by the first surface and securing the second surface to a second material (1) without adhesive."

This is quite simply wrong. She does not. This is the premise of none but the present application. This assertion by the Examiner is, with respect, a misinterpretation of the diagrams and a misunderstanding of the particular art. As said before, it is not possible that the Examiner has quoted any such matter from Wilkins and it is difficult to see from whence the error comes.

Wilkins's invention is a variation on the general cling PVC sign and is simply "a festive cling sign" and as such bears no relationship to the present (mount) claim nor, it is

contended, does it teach anything that would preclude granting the present application.

The present mount is a tool, an intermediary, to mount to glass a sheet, usually of paper, which would otherwise not adhere to the glass. The present application relates to a novel and unobvious device for attaching paper to glass. The Applicant therefore respectfully requests that the Examiner withdraw his objections given with reference to Wilkins.

### Illustration and Discussion of Treglown (App GB 2 333 050) and its Relevance to the Present Application

Treglown's invention is of a tag or panel, made from polyethylene, PVC or other plastic, which alters the characteristics of the surface a piece of paper to which a mastic is to be attached.

The device is a small panel of plastic, which, to quote Treglown, is "...to strengthen and protect a poster from damage that can be caused as a result of fixing said poster to a surface using adhesive putty or sticky tape."

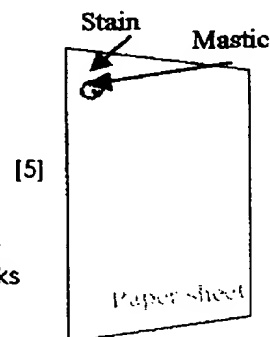
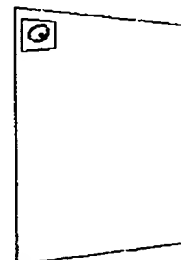


Figure [5] shows the subject of Treglown's abandoned application. She assumes the use of a mastic for the mounting method and seeks to alleviate the damage such mounting materials cause.

In order to modify the surface of the paper – and NOT to create any mount – Treglown proposes adhering small panels or tags to act as barriers to the oils and other contaminants from mastic.

The Applicant submits that we may not assume that anyone seeking a method to prevent damage to a poster from the mastic method of mounting, is in any way near the inventive step of the present application and the introduction of a new way of mounting using cling. [6]



There is no mention anywhere in Treglown's work of the use of cling properties. Her interest is in the barrier properties and the reinforcing capabilities of whichever plastic might be used.

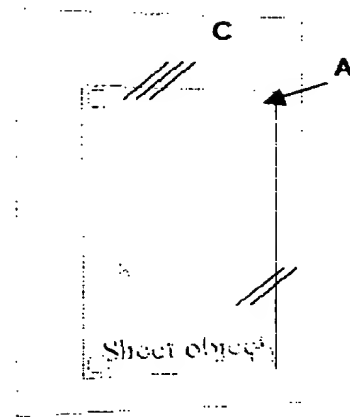
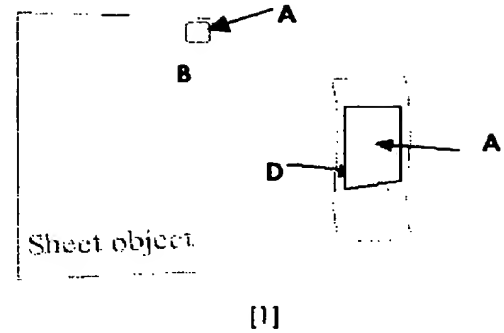
Treglown, like Wilkins, does not propose a mount. Treglown does not, it is contended, point to a new mount, or the possibility of it, based on cling properties. As the applicant's claims no longer refer to any cling property being well known, he requests that the Examiner remove his objection to the grant arising from Treglown.

**The Present Application, for comparison :**

Fig [1] :The mount, A, is shown in large scale.

It is adhered to a backing, or protective sheet, D by an adhesive layer which, on separation, remains on one side of the mount. This enables the mount to attach to a sheet object, B.

Two, or more usually, four mounts are attached to the sheet object, which is then adhered, Fig[2] to a glass surface, C, by the mounts, using the opposing side of the mount and the cling properties thereof.



**With regard to the importance of the claimed preferred sizes of the invented mount.**

On examining his arguments put previously, the applicant finds that there is little to be added to those and therefore reiterates them here – with the following additional comment :-

Following the initial inventive step of conceiving of using cling tags for hanging posters, work was done to determine how best to achieve this.

The applicant wishes to protect both the initial thinking and its refinement - the product arising out of the simultaneous optimisation of several factors or properties, which had then to be considered in unison to perfect the invention.

These were

1. Achieving optimum softness and therefore cling-strength of the PVC tag but at the same time meeting the need for some stiffness to prevent peeling from the glass under, for example, the possible bending action of paper curling in the sun. (Hence the reference to the percentage of softener)
2. Balancing the need for a small size (area) so that the mount is inconspicuous in use and easy to manipulate (A larger mount is not as acceptable cosmetically) with the need for determining a minimum size which would be capable of doing the job. (Hence the upper and lower limits of the sizes claimed)
3. Achieving the stiffness and peel resistance required as mentioned in 1. and balancing it with cost, meant optimising the thickness.

These were all done simultaneously.

The Examiner has stated that the sizes developed and the ratio of softener used are not important or unique to this invention and the patent would be difficult to police as others could latch on to the idea and just make different sizes or compositions. What is important to the applicant is to protect this particular combination of properties as well as the initial concept, because this is regarded as the optimum combination of properties and any products based on other combinations would not be as acceptable. The applicant has sought to show that the sizes mentioned are preferred sizes.

**The Applicant's previous argument on sizes :-**

The Examiner introduces the issue of the size ranges specified for the invented mounts, by referring to Wilkins.

Notwithstanding that the Applicant hopes to have persuaded the Examiner to withdraw Wilkins as irrelevant, this issue is addressed here.

The Examiner has decided that the preferred sized arrived at by the Applicant would have been obvious to Wilkins or anyone following the art. He further states that the expression used to describe the size of the present mount : -

" .. which adheres the mount to only a part of one surface of the sheet of paper..." does not have patentable weight. This expression, however, is used to distinguish between the present application and previously-cited art:-

An essential difference between the several arts cited by the Examiner and the present application, is that the sizes of the mounts in the present application are the deliberate result of experimentation to optimise the dimensions and other properties of the mount in question. The size is part of the idea. The applicant does not believe that the size of the present mount would be in any way obvious. As stated elsewhere, the decision to experiment with sizes to see if a small tag would work, was not obvious even to the applicant at first. The use of such small cling mounts as these is a first and an inventive step.

Several previously cited arts taught of sheets which adhered to other sheets such as paper - and which usually adhered to glass by cling - but all were of at least the same size as the paper of other sheet which was adhered to them.

Experimentation is stated in the present application, to have produced a fairly tight range of sizes, as described in the application, which, broadly, are those of a "small", "thin" mount.

By "Small" is meant that the mount (optimised at but not limited to 100 mm<sup>2</sup> - 900mm<sup>2</sup> and up to 2mm thick) is deliberately intended to fit into the corners of a sheet of paper which it is then intended to adhere to glass using several of these mounts. This, incidentally, is why the term "plurality" was used in this application. Not because the Applicant wished to claim the techniques for making a multiple item but to indicate that the intended use is, generally, of multiple mounts per sheet object. The discovery was that the holding performance of such small tags in sheer was sufficient to permit the specification of sizes which a) were so small as to be inconspicuous in performing the task and, therefore, b) a multiplicity of mounts would be used per application.

Even the upper size mentioned here is scarcely 1% of the area of, say, an A4 sheet of office paper. Therefore, to draw distinction between the mount and other devices, the sizes of the device are given and claimed (because they are the result of a period of empirical work - conducted in isolation from other art such as Wilkins, which is irrelevant in that it does not start out to do remotely the same thing. With respect to sizes, there was no prior art. The sizes are part of the intellectual property therefore and further emphasis is lent by including a claim that shows that the mount is designed to attach to a part, only, of the sheet, thus further defining the invention.

In the opinion of the applicant, this size-indicating phrase

" the first surface of each mount adheres the mount to only a part of the sheet of paper.." is as definite as, has the same weight as, the use, by Wilkins, (6,038,803) of: Claim 11, a) "said sheet of material is sufficiently sized to overlies completely an original picture of a picture holder". The applicant wishes to make it clear by this phrase, that the mount is quite different to any other use of cling PVC in the arts to date.

The applicant hopes that the matter of optimum sizes is presented clearly in the Specification.

#### **Action**

The Applicant wishes the claims relating to size to remain and requests the Examiner to further consider their acceptability in the light of the fact that it is established that there was no direct prior art from which to develop the invention.

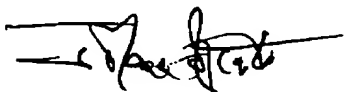
The applicant is of course very willing and most grateful to take the Examiner's guidance and comment to enhance this or any other aspect of the claims.

#### **Conclusion**

The applicant hopes that the present submission is procedurally acceptable and respectfully asks that the examiner withdraw his remaining objections to the patentability of the present application.

Should the examiner feel that a 'phone interview would be helpful, he is respectfully requested to contact the applicant, John MacAlister, on +44 1728 668 204, at any time, notwithstanding the time-zone differences, or to fax + 44 1728 668 664, giving a convenient time for the applicant to call back.

Submitted by



John MacAlister  
January 27th, 2006